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09/924,298	08/08/2001	Vincent Bryan	31132.70	3319
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EXAMINER				
PHILOGENE, PEDRO				
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3733				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/924,298

Applicant(s)

BRYAN ET AL.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 93-96, 101-103, 106-110, 112, 113, 121 and 122 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 91, 92 and 114-119 is/are allowed.
- 6) ☒ Claim(s) 3, 10-117, 23-44, 56-61, 66-71, 74-76, 86-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 3,10-17,23-44,56-61,66,67,70,71,74-76,86-96,101-103,106-110,112-119,121 and 122.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-61 are rejected under 35 U.S.C. 102 (b) as being anticipated by
Buttner-Janz et al. (5,401,269)

With respect to the above claims Buttner-Janz et al disclose a central body (3) and articulable between two shells (1,2), the central body being slidable relative to at least one of the two shells, wherein the central body has an upper and lower contact surfaces; as best seen in FIGS.1-11, and wherein in the absence of a compressive load, an upper shoulder is recessed into a portion of the perimeter (7) of the upper contact surface and a lower shoulder is recessed into a portion of the perimeter (7) of the lower contact surface; as best seen in FIGS.1-15; Wherein an upper shoulder extends around a portion of the perimeter of the upper contact surface and a lower shoulder extends around a portion of the perimeter of the lower contact surface and further wherein the upper shoulder defines a ledge, as best seen in FIGS.1-4,8,9, 15, indented into the perimeter of the of the upper contact surface of the central body; as set forth in column 2, line 63-68, column 3, lines 1-167, column 4, lines 1-37, and as best seen in FIGS.1-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuhrmann et al. (5,002,576) in view of Ray et al. (6,132,465).

With respect to the above claims, Fuhrmann et al disclose a bone joint implant comprising a sleeve (1) positioned between two opposing shells (3,4) has an upper and lower contact surface, and at least one sealable opening (21) in at least one of the shells, for the introduction of the lubricant into the implant after the implant has been assembled; as set forth in column 2, lines 50-68, column 3, lines 1-68, column 4, lines 1-12; and as best seen in FIGS. 1-4.

It is noted that Fuhrmann et al did not teach of the introduction of a lubricant material between the central body and the opposing shells; as claimed by applicant. However, in a similar art, Ray et al evidence the use of implant having a core and the introduction of lubricant to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Therefore, given the teaching of Ray et al it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Fuhrmann et al; as taught by Ray et al., to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Claims 3, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttner-Janz et al. (5,401,269) in view Buechel et al. (5,868,796) in view of Fuhrmann et al. (5,002,576) in view of Ray et al (6,132,465).

It is noted that the above combination of references did not teach of a liquid lubricant, which occupies at least a portion of the cavity and a closable passage between its outer surface and its inner surface; as claimed by applicant. However, in a similar art, Fuhrmann et al., evidence the use of openings in the shells to serve to fill or ventilate the interior of the implant.

Therefore, given the teaching of Fuhrmann et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Buttner-Janz/Buechel/Bryan et al, as taught by Fuhrmann et al., to serve to fill or ventilate the interior of the implant.

It is noted that the above combination of references did not teach of the introduction of a lubricant material between the central body and the opposing shells; as claimed by applicant. However, in a similar art, Ray et al evidence the use of implant having a core and the introduction of lubricant to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Therefore, given the teaching of Ray et al it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Fuhmann/Janz/Buechel et al; as taught by Ray et al., to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Claims 16,17, 23-44, 66,67,70,71, 86-90, are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttner-Janz et al. (5,401,269) in view Buechel et al. (5,868,796) in view of Bryan et al. (5,764,296) in view of Fuhrmann et al. (5,002,576) in view of Ray et al. (6,132,465).

With respect to the above claims, it is noted that the above combination of references teaches all the limitations; except for openings in the shell for injecting a liquid lubricant into the cavity; as claimed by applicant. However, in a similar art, Fuhrmann et al., evidence the use of openings in the shells to serve to fill or ventilate the interior of the implant.

Therefore, given the teaching of Fuhrmann et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Buttner-Janz/Buechel/Bryan et al, as taught by Fuhrmann et al., to serve to fill or ventilate the interior of the implant.

It is noted that the above combination of references did not teach of the introduction of a lubricant material between the central body and the opposing shells; as claimed by applicant. However, in a similar art, Ray et al evidence the use of implant having a core and the introduction of lubricant to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Therefore, given the teaching of Ray et al it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Furhmann/Janz/Buechel/bryan et al; as taught by Ray et al., to create an increase volume in the nucleus cavity revitalizing the overall disc space.

As to the language "adapted to being sealed with a plug" it is obvious that the opening of Furhmann et al is adapted to being sealed by a plug.

Allowable Subject Matter

Claims 91, 92, 114-119 are allowed.

Response to Amendment

First, the examiner agrees with applicant the previous Final Action was premature. However, this action is again made final.

Applicant's arguments filed 12/28/07 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 56-61, applicant's attention is directed to FIG.2 of Buttner-Janz. Contrary to applicant's arguments, in FIG.2 Janz shows a central body having an upper and a lower contact surface and a perimeter and an upper and lower shoulder recessed into a portion of the perimeter. As claimed by applicant the upper and lower shoulders only have to be recessed in o a portion of the perimeter. Applicant did not indicates where in the perimeter the shoulder must be recessed, as long as it recessed into a portion of the perimeter. Clearly the shoulder in Janz's reference recesses into a portion of the perimeter. Therefore, the reference to Janz meets the claims.

As to the arguments that the opening of Fuhrmann only serves to fill the interior with viscoelastic material and not for the introduction of a lubricant into the implant between the central body and opposing shells; first, applicant is not positively claiming these limitations. Applicant is only claiming that the opening is capable of introducing a lubricant. As can be seen, the opening of Fuhrmann is fully capable of introducing a

lubricant. Furthermore the reference to Ray et al did disclose of the use of a lubricant to create an increase volume in the nucleus cavity revitalizing the overall disc space.

Therefore, to combine the device of Fuhrmann and the device of Ray et al to arrive at applicant's device by introducing a lubricant into a disc replacement implant would have been obvious to one of ordinary skill in the art. Furthermore, the recitation that an element is "capable of" or "configured to" perform(ing) a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Exparte Masham*, 2 USPQ2d 1647 (1887).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Application/Control Number:
09/924,298
Art Unit: 3733

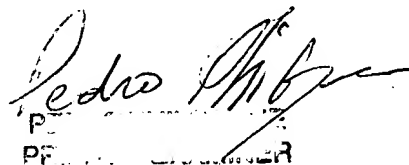
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
January 22, 2008



PF